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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,112	06/09/2000	Robert H. Hutchins, Jr.	HUTCP0101US	3415

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EXAMINER

MENDIRATTA, VISHU K

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 09/12/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/591,112

Applicant(s)

HUTCHINS, JR., ROBERT H.

Examiner

Vishu K Mendiratta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/27/03 and teleconver dated 9/4/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 18-23, 25, 26, 28 and 31-33 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-14, 18-23, 25, 26, 28 and 31-33 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This office action is upon further consideration and search.

Claim Rejections - 35 USC § 112

2. Claims 18,23,25,26,28,33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the claim is unclear in reciting the limitation that the spaces are "not a repeat pattern or a reverse repeat pattern". The claim indicates "what is not being claimed" and not rather "what is being claimed".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,3,9,31,32 rejected under 35 U.S.C. 102(b) as being anticipated by Calhoun (5,333,878).

Calhoun teaches a plurality of three dimensional playing segments (19) positioned relative to one another to form an array of spaces (Fig.1) as in applicant's claim 1,2 and 3, playing segments spaced apart with uniform voids (21) as in applicant's claim 9, void fillers (12) forming upstanding walls rising

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above playing segments (Fig.9) as in applicant's claim 1 and in a non-rectilinear form as in applicant's claim 31. The fillers are common to more than one segment as can be seen in fig.1, in that the fillers are positioned around more than one segment as in applicant's claim 32. Playing pieces (16) available for being placed on playing segments.

Applicant might argue that Calhoun invention is not about playing a chess game. Note that limitations "chess game playing array" and "chess game playing pieces selectively placed when a chess game is being played" are only intended use of the apparatus and do not add further limitation to the apparatus in the claim. Also note that applicant's limitation "segments are selectively positioned" is not specific enough to differentiate that the segments are "three dimensional separate playing segments" that are "selectively and removably positioned".

Claim Rejections - 35 USC § 103

5. Claims 4,5,6,7,8,10,11 rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun in view of Bulbrook (GB 2229099A).

Claim 5: Calhoun teaches all limitations except that it does not limit the segments to consist 64 segments. Bulbrook teaches a chess game having 64 segments (Fig.2). The conventional game of chess with its 64 spaces is a widely practiced game and attracts players easily. In order to attract the chess-playing enthusiasts towards a game, it would have been obvious to form a game consisting 64 spaces. One of ordinary skill in art at the time the invention was made would have suggested having 64 segments.

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Claims 4,6,7,8,10,11: Calhoun teaches all limitations except that it does not teach placing segments at various elevations. Bulbrook teaches placing segments at various elevations. While there is no criticality illustrated for applicant's game having segments being placed at various elevations, games are often constructed to attract players by their aesthetical appearances. In order to change the aesthetical appearance and for attracting players it would have been obvious to place segments at various elevations to create the look of a stadium or the look of a terrain. One of ordinary skill in art at the time the invention was made would have suggested placing segments at various elevations for aesthetic reasons.

Note that changing the shape (as in applicant's claims 4 and 10) or size of a playing segment is a matter of aesthetical change and does not differentiate the game. In order to make the game attract players, it would have been obvious to change shapes of playing segment. One of ordinary skill in art at the time the invention was made would have suggested variation in shapes to attract players.

6. Claims 12,13,14 rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun in view of Gaito (5462281).

Calhoun teaches all limitations of these claims except that it does not teach an accessible inside and light in the segment and it being transparent/translucent. Gaito teaches interior of segments having light bulbs (50,52) and translucent window (46).

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In order to make the playing positions illuminated, it would have been obvious to provide electric bulbs in the interior of the segments surrounded by transparent/translucent walls.

One of ordinary skill in art at the time the invention was made would have provided a bulb in the interior of the segments for illuminating purposes.

7. Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun in view of Eplett (4696476).

Calhoun teaches all limitations of this claim except that it does not teach connecting two 4x8 segments to make a 8x8 board.

Eplett teaches connecting segments of game to form a game (Fig.4-6). In the art area of board games, making boards in segments is commonly known for easy storing purposes. In order to easily store, it would have been obvious to make game board in two pieces. One of ordinary skill in art at the time the invention was made would have used segments of boards for easy storing reasons.

8. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun in view of Hullinger (6,279,907).

Calhoun teaches all limitations of these claims except that it does not teach implementation of the game on computer.

Hullinger teaches implementation of such a game having segments on computer and use of software (Abstract).

In order to popularize the game, it would have been obvious to implement the game on computer.

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One of ordinary skill in art at the time the invention was made would have implemented the game on computer for large number of people to access the game.

9. Claims 23,25,26 rejected under 35 U.S.C. 103(a) as being unpatentable over Eplett (4696476) in view of Moore (511306).

Eplett teaches segments with different motifs disposed to each other to form a game of chess (Fig.6), segments sloping down towards each other.

Eplett does not teach consisting two pieces. Moore teaches a game consisting two pieces. (Fig.3).

In the art area of board games, making boards in segments is commonly known for easy storing purposes. In order to easily store, it would have been obvious to make game board in two pieces. One of ordinary skill in art at the time the invention was made would have used segments of boards for easy storing reasons.

Note: Segments are not being claimed separate and removably positionable.

10. Claims 28,33 rejected under 35 U.S.C. 103(a) as being unpatentable over Eplett (4696476) in view of Harris (Des349521)

Eplett teaches segments with different motifs disposed to each other to form a game of chess (Fig.6), segments sloping down towards each other.

Eplett does not teach consisting three segments. Harris teaches a game consisting three segments. (Fig.1).

In the art area of board games, making boards in segments is commonly known for easy storing purposes. In order to easily store, it would have been obvious to

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make game board in three segments. One of ordinary skill in art at the time the invention was made would have used segments of boards for easy storing reasons.

Note: Segments are not being claimed separate and removably positionable.

Response to Arguments

11. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number

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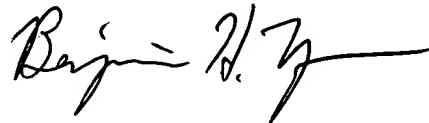
is (703) 306-5695. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T. Sewell can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Vishu K Mendiratta
Examiner
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VKM

A handwritten signature in black ink, appearing to read 'Benjamin H. Layno', with a long horizontal flourish extending to the right.

Benjamin H. Layno
Primary Examiner